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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,321	01/06/2005	Serge Creutz	SN132 PCT 1	9052
137 7590 12/23/2008 DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994				
EXAMINER PENG, KUO LIANG				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
12/23/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

### Office Action Summary

**Application No.**

10/521,321

**Applicant(s)**

CREUTZ ET AL.

**Examiner**

Kuo-Liang Peng

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/7/08 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,10,11,15-17,19,23 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,10,11,15-17,19,23 and 27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The Applicants' amendment and the affidavit under 37 CFR 1.132 filed October 7, 2008 are acknowledged. Claims 2, 5-9, 12-14, 18, 20-22 and 24-26 are deleted. Claims 1 and 23 are amended. Claims 27-30 are added. Claims 1, 3-4, 10-11, 15-17, 19, 23 and 27-30 are pending.
2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 20080329) is/are removed.
3. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

### ***Claim Rejections - 35 USC § 112***

4. Claims 1, 3-4, 10-11, 15-17, 19, 23 and 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1 (line 10 from bottom) and Claim 23 (line 10 from bottom), “which are esterified by carboxylate groups” causes confusion because carboxylate groups are ester groups, per se, and cannot be further esterified.

5. Claims 1, 3-4, 10-11, 15-17, 19, 23 and 27-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In Claim 1 (line 6), Examiner is not able to find “fatty acids having 8 to 32 carbon atoms” (Emphasis added)

***Claim Rejections - 35 USC § 102 and 103***

6. Rejection of Claims 1, 3-4, 10-11, 15-17, 19 and 23 under 35 USC 102(a) as being anticipated by Dickinson (GB 1 523 957) is maintained because the rejection is adequately set forth in paragraph 8 of Paper No. 20080329. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

The instant rejection will be removed when the rejections under 35 U.S.C. 112 are properly overcome.

*Claim Rejections - 35 USC § 103*

7. Claims 1, 3-4, 10-11, 15-17, 19, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US 6 610 752) in view of L'Hostis (EP 1 075 863).

For Claims 1, 3-4, 10-11, 15, 17, 19, 27 and 29, Schmid discloses a method of manufacturing a granular foam control composition comprising a **polydiorganosiloxane** containing methyl, ethyl, propyl, butyl and phenyl groups, a **microfine silanized silica**, a **polyol ester** such as the esters of glycerol and palmitic acid (typically containing a mixture of **glycerol mono, di-, and tripalmitate**), etc., a bisamide, a **fatty acid**, a microcrystalline paraffin wax. (col. 2, line 34 to col. 5, line 56 and Examples) The silica can be silanized and dispersed in the polydiorganosiloxane. (col. 2, line 34 to col. 3, line 18) The granular foam control composition can be prepared according the method described in col. 3, line 19 to col. 4, line 13, col. 5, line 57 to col. 7, line 67 and Examples. Schmid is silent on the polydiorganosiloxane where the substituents have the claimed mean number of carbon atoms, the claimed long chain alkyl group or the claimed X-Ph moiety.

L'Hostis teaches the use of in a foam control composition a polyorganosiloxane that read on the claimed ones. The motivation of using the specific polyorganosiloxane is to afford a granular foam control composition with **enhanced foam control efficiency**. (col. 2, lines 46-51, col. 2, line 64 to col. 3, line 46, col. 4, line 64 to col. 5, line 28 and col. 7, line 65 to col. 8, line 35) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize L'Hostis' polyorganosiloxane in Schmid's composition with expected success. Especially, L'Hostis is in the same field as that of Schmid's endeavor. Schmid teaches depositing the polydiorganosiloxane, polyol ester, etc. in aqueous liquid form onto the particular carrier. (col. 2, lines 5-30) However, the water is eventually removed. (col. 22, lines 12-25) As such, the prior art's granulated foam control composition is obviously the same as the claimed granulated foam control composition where the polydiorganosiloxane, polyol ester, etc. is used in non-aqueous form. For Claim 16, Schmid is silent on the **microfine** silanized silica having the claimed average particle size. However, L'Hostis teaches that it is well known to use hydrophobic fillers such as silica with particle size of 0.5 to 50 **microns** for foam control agents. The silica is well known and is **commercially available**. (col. 6, line 60 to col. 7, line 28) As such, it would have been obvious to one of ordinary skill in the art at

the time of the invention was made to utilize L'Hostis' silica filler in Schmid's composition because Schmid's silica is **microfine** and the commercial availability of L'Hostis' silica. Especially, L'Hostis is in the same field as that of Schmid's endeavor, and Applicants do not show the **criticality** of the particle size.

For Applicants' argument (Remarks, page 11, last paragraph), Examiner disagrees. The affidavit filed concurrently is not persuasive because it is not commensurate with the scope of at least Claim 1. The affidavit made a comparison between the composition according to the present invention and that based on the disclosure of Schmid alone. However, the composition according to the present invention should have adequately been compared against the disclosure of Schmid where Schmid's polydiorganosiloxane fluid is replaced with L'Hostis' polydiorganosiloxane fluid.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed

within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about



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the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

December 16, 2008

/Kuo-Liang Peng/

Primary Examiner, Art Unit 1796